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No. 905-65

IN THE

Supreme Court of the United States

OCTOBER TERM, 1965

GEORGE C. TIBBETTS,
Petitioner,

v.

HUGH S. KNOWLES,
Respondent.

KNOWLES REPLY TO TIBBETTS PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

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Petitioner Tibbetts seeks a writ on the ground that a question of law is involved:

> "Can an abstruse electroacoustic invention be reduced to practice without causing it to perform its intended function?" Petition, page 2.

Tibbetts now seeks to shift from issues of fact in the Court below to an issue of law in this court.

Both of respondent Knowles' briefs, which alone were filed here, sought to convince the Court of Customs and Patent Appeals that the Patent Office erred on issues of fact. The same is true of petitioner Tibbetts' brief and his petition for rehearing addressed to the court below. These briefs were not filed as part of this record. By not filing them, Tibbetts has made it somewhat difficult to verify his shift from issues of fact to an issue of law, but the decision itself proves this shift from fact to law. The court below, after describing the invention, devotes all but the last paragraph of its decision to resolving issues of fact, see Appendix A of the petition.

This court reaffirmed earlier holdings as to what constituted a reduction to practice in *Corona Cord Tire Co.* v. *Dovan Chemical Corp.*, 276 U.S. 358 at 383 and 384, 48 S.Ct. 380, 72 L.Ed. 610 (1927), saying:

> "A process is reduced to practice when it is successfully performed. A machine is reduced to practice when it is assembled, adjusted and used. A manufacture is reduced to practice when it is completely manufactured. A composition of matter is reduced to practice when it is completely composed. * * * (page 384) It is a mistake to assume that reduction to use must necessarily be a commercial use."

The court below phrased the rule of law that it was applying as follows:

> "Although tests under actual conditions of use are not necessarily a requirement for reduction to practice, the tests must prove that the invention will perform satisfactorily in the intended functional setting, *White* v. *Lemmerman*, 52 CCPA 968, 341 F.2d 110, 144 USPQ 409 and *Paivinen* v. *Sands*, 52 CCPA 906, 339 F.2d 217, 144 USPQ 1." Petition, page 5a

The respondent Knowles submits that the court below was applying the very rule established by this court.

The only issues in this interference are issues of fact.

The question submitted by petitioner Tibbetts involves two issues of fact. The question describes the invention as "abstruse." This is a question of fact, and it was found against him. Prior to making the invention at issue, respondent Knowles' assignee was selling the transducer shown in Figure 2 on page 2a of Appendix A of the petition,—excepting that the armature 27 did not project as shown by the lead line 40. For adjustment purposes, he substituted a T-reed 2 as shown in Figure 5 on page 3a of Appendix A of the petition, for a straight reed in the transducers then on the market. His only question was whether microphones containing the T-reeds or armatures would work as well as one containing the straight reed. It would be hard to conceive a more simple invention. The corroborating witness Cronk said that, "once they" (the T-reeds) "were in the acoustic state they were indistinguishable from any other reed."

The second fact issue arising from petitioner Tibbetts' question arises from his stating in his brief that the "intended function" was to adjust the magnetic balance after a diaphragm had been attached. This is a question of fact. Respondent Knowles says that the intended function is to magnetically balance the motor when the armature is off center for any reason. Adjusting for some causes is done before the motor is placed in a case. Tibbetts' statement in lines 4-10 on page 6 of the petition is exactly wrong. If the word "not" in line 7 is omitted, the statement is right. This is an issue of fact. The court below supported respondent Knowles:

> "We thus conclude that Knowles made a miniaturized transducer and tested to establish *that reluctance could be varied by manipulation of tabs on the T-reed.*" Petition, Appendix A, page 8a, emphasis by respondent Knowles.

Nothing is said about the particular use to which Knowles wished to place the invention.

Knowles submits that the proffered question of law is merely two issues of fact, and that these fact issues were carefully examined by the court below.

Petitioner Presents No Reason for Granting the Petition

Rule 19 of this court sets forth the grounds for granting a petition for certiorari. Respondent Knowles submits that the petition should be denied because the reason for granting the writ is not obvious, and the brief does not state under what reason given in Rule 19 of this court, the petition could be granted. The only reason in Rule 19 that could be pertinent is "has decided a federal question in a way in conflict with applicable decisions of this court." As set forth above, the Court of Customs and Patent Appeals stated the law in language similar to that used by this court when previously establishing the law.

Abandonment

The petition is confusing because it states that the statute involved is U.S.C., Title 35, §102(g). On the question asked by petitioner Tibbetts, the statute is U.S.C., Title 35, §102(a). The issue relates to inventorship and to completion of an invention. Section 102(g) has two sentences. The first relates to abandonment, concealment and suppression, and on this the court below remanded to the Patent Office to make findings of fact, see page 11a of the petition. The second sentence of §102(g) has no applicability to the facts here. Knowles' position has been from

the beginning that he was first to conceive and first to reduce to practice. Under such a position, there is no question involving diligence by any party.

Respectfully submitted,

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